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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,971	09/24/2003	Manfred Boller	2001P02943WOUS	1458
28204 7590 03/09/2007 SIEMENS SCHWEIZ AG I-47, INTELLECTUAL PROPERTY ALBISRIEDERSTRASSE 245 ZURICH, CH-8047 SWITZERLAND			EXAMINER HAGEMAN, MARK	
			ART UNIT 3653	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/09/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/668,971

Applicant(s)

BOLLER ET AL.

Examiner

Mark Hageman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) 4-17 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-14-2006 has been entered.

Claim Objections

2. Claim 4 is objected to because of the following informalities: In line 13 the word "filing" should be filling such that the claim would read "the filling position being...". Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 4-9 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Schuster et al., Schuster discloses a sorting path (5) along which the container (7) can

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be filled with the sorted items; a plurality of destination points positioned along the sorting path, the destination points providing the sorting items to the container; a transport facility located proximate to the sorting path and destination points, the transport facility transporting the container from a destination point (col. 3, lines 53+); a holder (10) for accommodating the container therein; a guide (11) facilitating lateral movement of the holder beneath the destination point and configured to position the container in and out of a filling position, the filling position being a position wherein the container can be filled with the sorted items, wherein the guide withdraws the receiving container and the holder at least once for filling with sorted items so that the receiving container is removed from beneath the destination point during filling, wherein a withdrawing direction is crosswise with respect to a sorting path direction and opposite to an insertion direction (figure 2 ad c4 lines 20+), and the guide reinserts the container and holder after filling so that the container is positioned beneath the destination point; and a lift (12) located proximate to the container, the lift facilitating raising and lowering of the container from the holder to the transport facility (8) (col. 4, lines 14+).

Examiner contends that the language, "wherein the guide withdraws the receiving container and the holder at least once for filling with sorted items so that the receiving container is removed from beneath the destination point during filling" and "the guide reinserts the container and holder after filling so that the container is positioned beneath the destination point" is functional and therefore not given patentable weight. The statements describe the function of the apparatus and how the guide interacts with the container during operation but fails to provide structural limitations distinguishing the

claim from the prior art. As set forth in MPEP 2114 Apparatus claims must be structurally distinguishable over the prior art.

With regards to claim 5, the reference further discloses means for moving the container from a filling position into and out of a ready position beneath the destination point (col. 4, lines 14+).

With regards to claim 6, the reference further discloses the holder (10) comprises a holding frame (11) facilitating accommodation of the container and a handle (12) facilitating movement of the holder.

With regards to claim 7, the reference further discloses at least one actuation element effecting initiation of a control command for removal and transportation of the receiving container (col. 4, lines 54+).

With regards to claim 8, the reference further discloses the lift further comprises means for first raising the receiving container from the ready position and, after the holder has moved into the filling position, lowering the container onto the transport facility (col. 4, lines 43+).

With regards to claim 9, the reference further discloses control elements for controlling and monitoring the removal and transportation of the receiving container (col. 4, lines 54+).

With regards to claim 15, the reference further discloses a transport facility section composed of a plurality of destination points (Fig. 1).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10-14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuster et al. in view of Olson et al. Schuster et al. fails to explicitly disclose means for detecting a presence of the receiving container in the ready position, means for detecting the holder in the filling position, at least one control element is located at an uppermost and lowermost position of the lift and further comprises means for detecting if the lift is in the uppermost and lowermost positions, at least one control element comprises means for detecting an idle position of the lift, at least one control element comprises means for controlling and monitoring the removal and transportation of the receiving container on the transport facility at least one control element is located at a beginning and end of a transport facility section, at least one control element is located at a beginning or end of a transport facility section. Olsen et al. discloses the use of sensors to determine positions of different elements to facilitate control of the apparatus (col. 17, lines 1+). Additionally, the use of sensors to determine positions of different elements to facilitate control of the apparatus is well known in the art of mail sorters. At the time of the invention, it would have been obvious to one of ordinary skill in the art to utilize control elements to facilitate automatic control of the apparatus.

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Schuster et al. and Olson et al. are analogous art as they are from the same field of endeavor: mail sorters.

Allowable Subject Matter

7. Claims 1-3 are allowed.

8. The following is an examiner's statement of reasons for allowance: The prior art fails to disclose or render obvious the receiving container being withdrawn such that it is removed from beneath the destination point during filling and subsequently reinserting the container along with the other limitations set forth in claim 1.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

Applicant's arguments see pages 8 and 9, filed 12-14-2006, with respect to claims 1-3 have been fully considered and are persuasive. The rejection of claims 1-3 has been withdrawn.

9. Applicant's arguments filed 12-14-2006 regarding claims 4-17 have been fully considered but they are not persuasive. Applicant asserted that claims 4-17 distinguish over the prior art for the same reasons as claim 1. Specifically the function of the device and the interaction between the guide and the container have been described in

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the claim in further detail. While these limitations are granted patentable weight in process claims, in this case claims 1-3, they fail to provide further structural limitations and are thus not given patentable weight in the apparatus claims 4-17.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Hageman whose telephone number is (571) 272-3027. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH

A handwritten signature in black ink, appearing to be 'PM' or similar initials, written in a cursive style.

PATRICK MACKEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600